IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chavez, Jr.**

Serial No.: **09/292,190**

Filed: **April 15, 1999**

For: **Method and System for Enabling a Network Function in a Context of One or All Server Names in a Multiple Server Name Environment**

§ Group Art Unit: **2151**
§
§ Examiner: **Dinh, Khanh Q.**
§
§ Attorney Docket No.: **AT9-98-737**
§

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By: Rebecca Clayton
Rebecca Clayton

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Docket No. AT9-98-737 *PATENT*

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Group Art Unit: **2151**

Examiner: **Dinh, Khanh Q.**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

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By: Rebecca Clayton
Rebecca Clayton

REPLY BRIEF

This brief is in furtherance of the Appeal Brief filed in this case on September 29, 2003 and the Examiner's Answer mailed December 22, 2003.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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RELATED APPEALS AND INTERFERENCES

The Examiner's Answer erroneously states that Appellants' brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by the pending appeal. Appellants' respectfully direct the Board's attention to page 2 of Appellants' brief which clearly states that there are no related appeals or interferences. Thus, Appellants' brief does contain a statement as to related appeals and interferences.

RESPONSE TO EXAMINER'S ARGUMENTS

I. Group I: Server Name Mask and Server Name Context

Appellants argued, in their brief filed September 29, 2003, that neither French nor Nishimoto teach or suggest generating a server name mask based on a server name or executing a function in a server name context on a server based on the generated server name mask. In response to this argument, the Examiner's Answer states:

> Examiner respectfully points out that Nishimoto discloses masking process based the retrieval acceptance from the host server name and generating a permission IP server host name and a refusal IP server host name (see figs. 7, 20A and 20B, abstract, col. 12 line 20 to col. 13 line 60 and col. 23 line 1 to col. 24 line 60).

The Examiner's statement is not clear as to what element in Nishimoto the Examiner believes is the same as the server name mask recited in the claims. However, Appellants will address each of the sections of Nishimoto that the Examiner points to in this statement. First, looking to Figures 7, 20A and 20B, none of these Figures illustrate a server name mask generated based on a server name or executing a function in a server name context on a server based on the generated server name mask. As shown and described in column 12, lines 20-43, Figure 7 merely shows connection notification destination information which is stored into a connecting situation database provided for the connection server. This connection notification destination information includes an identifier code 124 of the peer client 10 which registered and one or

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more IP-server host names 146 of the IP servers serving as connection notification destinations. Column 12, lines 20-43, which describe Figure 7, merely states that the connection notification destination information shown in Figure 7 is edited by the public personal information processing unit 54 of the peer client 10 in Figures 2A to 2C and is transmitted together with the connection information and the like when the connection to the connection server 12 is started and is registered into the connecting situation database 36. Nothing in Figure 7, or its accompanying description in column 12, teaches or even suggests generating a server name mask based on a server name or executing a function in a server name context on a server based on the generated server name mask.

The remaining portion of column 12, line 20 to column 13, line 60, cited by the Examiner, also does not teach or suggest these features. Column 12, line 44 to column 13, line 20 describes Figure 8 which depicts the public personal information 102 which is registered into the public personal information database provided for the connection server 12 in Figures 2A to 2C. Nowhere in the description of this public personal information is there any mention of generating a server name mask based on a server name or executing a function in a server name context on a server based on the generated server name mask. To the contrary, all that this section of Nishimoto teaches is that the public personal information includes inevitable public items 148 and option public items 150 and provides details about this information. Neither of these portions of information include a server name mask, let alone a server name mask that is generated based on a server name or executing a function in a server name context based on the server name mask.

Column 13, lines 21 to 60 merely describes use permission information in the public personal information being constructed from inevitable public item permission information, option public item use permission information, an active publication, and an ID code. The inevitable public item use permission information and option public item use information may have a permission IP server host name and refusal IP server hose name registered. Nishimoto does state at column 13, lines 55-60 that "the connection server 12 actively transmits information indicating that an access permission and an access refusal have already been issued to a plurality of IP servers 14 having those IP server host names, thereby realizing more rapid and efficient information providing from the IP server 14 side." However, nowhere in column 13 is a server name mask ever even hinted at, let alone specifically taught or suggested. The term "mask" or

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"masking" does not even appear in this cited section of Nishimoto. Therefore, it is not understood how the Examiner can still allege that this section of Nishimoto teaches a server name mask.

With regard to Figures 20A, 20B and column 23 line 1 to column 24, line 60, the only places within these cited sections that "masking" is referenced are the following statements:

> Thus, the connection information of the user A is transmitted via the masking process based on the retrieval acceptance, reference to the connection destination information, and reference to the connection permission information in step S103.
> (column 23, lines 62-66; emphasis added)

> In response to the retrieval request, the connection server 12 similarly executes an acceptance of the retrieval, a reference to the connection destination information, and a reference to the connection permission information, executes the masking process to the connection information, and after that, transmits the resultant information in step S104.
> (column 24, lines 16-23; emphasis added)

> For a retrieval request of the connection information in which the ID code "xyz" was designated form the IP server 14-2 of the J company due to an accidental purpose or a mistake which ordinarily cannot occur, in the connection permission information 96 of the connection server 12, the real estate company J has been registered to "refusal IP server host name" with respect to all of the emergency channel 142, so that the passwords of all the channels in the original connection information 94-1 are mask-processed.
> (column 24, lines 38-48; emphasis added)

All that these sections of Nishimoto teach is what was argued in Appellants' brief, i.e. that the "masking" performed in Nishimoto involves the sending of connection information, i.e. the IP address of the client and the password, associated with a connection type with which the server may communicate with the client. The "masking" in Nishimoto is not associated with the generation of a server name mask based on a server name and is not used to execute a function in a server name context on a server. To the contrary, the "masking" in Nishimoto is used to send the IP address and password to the server for only the channels that the server can use to communicate with the client as defined by the connection permissions. The "mask" of Nishimoto has nothing to do with executing a function in a server name context and is not generated based on a server name. The sections of Nishimoto relied upon by the Examiner in the Examiner's Answer do not do anything to

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show where such features are taught in Nishimoto. Other than merely using the term "masking", the cited sections have nothing to do with the actual masking recited in the claims of Group I.

Thus, Appellants respectfully submit that, despite the Examiner's allegations to the contrary, Nishimoto does not teach or suggest a server name mask or executing a function in a server name context on a server based on the server name mask. Since the Examiner has admitted that French does not teach these features, and Appellants have shown that Nishimoto does not teach or suggest these features, any alleged combination of French and Nishimoto, even if such a combination were possible and one of ordinary skill in the art were somehow motivated to combine the references in the manner alleged by the Examiner, would still not result in the invention recited in the claims of Group I.

II. Group I: No Suggestion to Combine References

In response to Appellants' arguments that French and Nishimoto are directed to two completely different systems, there is no motivation to combine these references in the manner alleged by the Examiner, and that the alleged motivation is not based on the actual teachings of the references, the Examiner responds:

> In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nishimoto discloses generating a server name mask based on the server name and executing the function in a server name context on the server as directed by the input specifying the server name based on the server name mask (i.e., masking process based the retrieval acceptance from the host server name 218, see figs. 7, 20A and 20B, abstract, col. 12 line 20 to col. 13 line 60 and col. 23 line 1 to col. 24 line 60). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Nishimoto's teachings into the computer system of French to control the transmission data because it would have provided a masking process to the personal access information and provided a more secure network environment (see col. 2 lines 40-64).

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First, as stated above, the Examiner is mistaken with regard to Nishimoto's alleged teaching of a server name mask and executing a function in a server name context on a server based on a server name mask. As stated above, and in Appellants' brief, there is nothing in Nishimoto that teaches such features. To the contrary, the masking performed by Nishimoto is with regard to the IP address and password that a server may use to communicate with a client and is not based on a server name.

Second, the Examiner's alleged rebuttal of Appellants' arguments is nothing more than a reiteration of the erroneous "motivation" provided in the Final Office Action with some boilerplate case law thrown in. The Examiner's statements do not rebut Appellants' arguments with regard to the references being directed to completely different systems that are not combinable. The Examiner's statements do not rebut Appellants' arguments that the alleged motivation of providing a "masking process to the personal access information" and providing "a more secure network" is not based on any teaching or suggestion in the references.

As was clearly stated in Appellants' brief, French is directed to a method and system for allowing a single server to respond to multiple network names. Nishimoto is directed to a system for allowing servers to initiate information downloads to client devices based on registered information types of interest to the users of the client devices and their designated channel permissions. These systems have nothing in common other than being in a data processing network. One of ordinary skill in the art, being presented only with these references and not having a prior knowledge of Appellants' claimed invention, would not even consider combining the references, let alone combining them and modifying them in the specific manner that would be necessary to arrive at Appellants' claimed invention. There is absolutely nothing in either reference that would suggest to one of ordinary skill in the art to do so.

The alleged "motivation" offered by the Examiner has nothing to do with why it would be obvious to combine such different systems and modify them to arrive at Appellants' claimed invention and is merely an attempt by the Examiner to generate a motivation when there simply is none. This is evident in that the section of Nishimoto the Examiner cites for support of the "motivation," i.e. column 2, lines 40-64, does not teach or suggest anything with regard to masking, i.e. the feature that Nishimoto allegedly teaches and is the basis for including Nishimoto in the alleged combination of references.

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Furthermore, as stated in Appellants' brief, the very statements made by the Examiner illustrate that the motivation is not based on any real teaching or suggestion in the references. The masking in Nishimoto is not performed on personal information. To the contrary, the masking in Nishimoto is directed to connection information, namely the IP address and password used by the server to transmit information to the client over a particular priority communication channel, i.e. emergency, regular confirmation, or preservation. Moreover, the masking is not performed to increase the security of the system but rather is used as a way for the user of the client device to control which servers may send information to the client and at which priorities the information is to be displayed on the client. Thus, the alleged motivation has no basis in the actual teachings or suggestions of the references and the Examiner has not rebutted Appellants arguments but merely restated his position.

Therefore, for the reasons stated above, and the reasons set forth in Appellants' brief, Appellants respectfully request that the rejection of the claims in Group I, i.e. claims 1-4, 7, 12-15, 21 and 22, be overturned.

III. Group II: Generating a Server Name Tag

In response to Appellants argument that neither French nor Nishimoto teach or suggest generating a server name tag based on a value of a server name and a value derived from a data structure that stores the server name, the Examiner states:

> Examiner respectfully disagrees. French discloses using data structures containing server name table that contains a set of server names (i.e., alpha, theta, omega) such as primary names and second primary names, see fig. 5, col. 9 line 53 to col. 10 line 54 and col. 11 lines 3-67).

Simply because French teaches a server name table does not mean that French teaches or even suggests generating a server name tag based on a value of a server name and a value derived from a data structure that stores the server name. The claims specifically recite that two values are used: a first value that is a value of the server name, and a second value that is derived from a data structure that stores the server name. These two values, together, are used as a basis for generating a server name tag. Teaching a server name table in which server names are stored does not teach or

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even suggest this feature. As with the other rejections made by the Examiner, the rejections are merely based on the Examiner having found some of the words of the claims in the references, regardless of the context in which those words are used, and generating a rejection simply because some of the same words are used in the references. The rejections are not based on the actual teachings and suggestions of the reference but rather, a prior knowledge of Appellants' claimed invention, the identification of references that happen to include some of the same words, and a sole purpose of attempting to reject the claims, despite the actual teachings of the references.

Appellants will admit that French teaches server names and a server name table, as is clearly illustrated in Figure 5, elements 542-546. However, this in no way obviates the specific feature of generating a server name tag based on a value of a server name **and** a value derived from a data structure storing the server name. The Examiner's alleged rebuttal of Appellants' arguments merely amounts to a reiteration of the position espoused in the Final Office Action with no explanation as to why Appellants' arguments are allegedly incorrect. To the contrary, as discussed in Appellants' brief and above, the Examiner's own statements illustrate the lack of teaching or suggestion in the references with regard to the features of claims 5 and 16. Therefore, Appellants respectfully request that the Board overturn the rejection of claims 5 and 16.

IV. Group III: Value Derived from Data Structure is Position Value of Server Name

In response to Appellants' argument that neither reference teaches or suggests that the value derived from the data structure is a position value of the server name within a server name table that stores the set of server names, the Examiner states:

> Examiner respectfully point out that French discloses using data structures containing server name table (542, fig. 5) that contains a set of server names, such as primary names and second primary names (see fig. 5, col. 9 line 53 to col. 10 line 54 and col. 11 lines 3-67).

Again, the Examiner apparently thinks that simply because French teaches a server name table, then it must necessarily teach that a value derived from a data structure, which is a basis for generating a server name tag, is a position value of the server name within the server name table. The Examiner is wrong.

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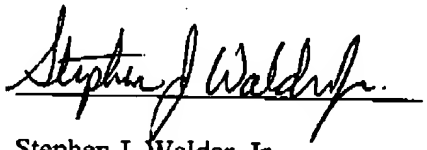
Just because a server name table is taught in French does not mean that French suddenly teaches generating a server name tag. Furthermore, a server name table being taught in French does not suddenly teach or suggest generating a server name tag based on a value of a server name and a value derived from a data structure that stores the server name. Moreover, a server name table being taught in French does not suddenly teach or suggest generating a server name tag based on a value of a server name and a position value of the server name within a server name table. The Examiner has not pointed to so much as one sentence in French that teaches or suggests such features. All the Examiner has shown is that French teaches a server name table. Appellants are not claiming a server name table. Appellants are claiming the specific features of generating a server name tag based on a value of a server name and a position value of the server name within a server name table. These features are not taught in the references and the Examiner has failed to show where they are taught or even suggested in the references. Thus, the Examiner has failed to establish a prima facie case of obviousness with regard to claims 6 and 17 and the Board should overturn these rejections.

V. Conclusion

In view of the above, and the arguments presented in Appellants' brief filed September 29, 2003, Appellants respectfully submit that the claims of the present application define over the French and Nishimoto references. Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences overturn the rejections set forth in the Final Office Action.

Respectfully submitted,



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